REMARKS

Applicants have now had an opportunity to carefully consider the prior art and the Examiner's comments set forth in the Office Action of November 24, 2009. Claims 1-25 are pending in this application.

Reconsideration and reexamination of the Application are requested.

I.   The Office Action

The specification filed November 25, 2008 is objected to under 35 U.S.C. § 132(a) because it introduces new matter into the disclosure.

Claim 14 is objected to because of minor informalities.

Claim 1 is rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

Claim 1 is rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement.

Claim 1 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-4, 7, 9-15 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,532,351 to Richards et al. (hereinafter "Richards") in view of U.S. Patent Application Publication No. 2004/0080775 to Owen et al. (hereinafter "Owen") in further view of U.S. Patent No. 5,930,553 to Hirst et al. (hereinafter "Hirst").

Claims 5-6, and 8 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Richards in view of Owens in further view of Hirst and in further view of well-known art.

Claims 16-22 are rejected as being unpatentable over Richards in view of Owens in further view of U.S. Patent No. 7,262,873 to Rasche et al. (hereinafter "Rasche") and in further view of U.S. Patent Application Publication No. 2003/00763305 to McIntyre (hereinafter "McIntyre") and in further view of Hirst, further in view of U.S. Patent Application Publication No. 2004/0045000 to Hara (hereinafter "Hara").

Claims 23-25 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Richards in view of Owen in further view of Rasche in further view of McIntyre in further view of Hirst, in further view of Hara, and in further view of well-known prior art.

II. Objection to the Specification

The amendment filed 11/25/09 is objected to because it allegedly introduces new matter. Specifically, the Examiner asserts that claim 1 recites the limitation "ceasing operation of the printing apparatus" and claim 9 recites "non-consumable memory" and these limitations are not supported by the specification. Applicant asserts that claim 1 has been amended to re-phrase the limitation to recite "causing said printing apparatus to idle." Support for this amendment may be found in paragraph [0040]. The amendment does not require an additional search by the Examiner, since the present amendment and the prior limitation have the same meaning and are only worded differently. Applicant further asserts that claim 9 has been amended to remove "non-consumable" from the claim.

III. Claim Objections

Claim 14 is objected to for including "comprised of" two times and failing to provide sufficient antecedent basis for the limitations "the Internet." Claim 14 is amended, deleting one "comprised of." As for the limitation "the Internet," Applicant asserts that there the Internet is being used as a proper noun, and there is only one Internet. Therefore, since there is only one, "an Internet" would be improper.

IV. §112 Rejections

Claims 1 and 9 are rejected under 35 U.S.C. 112, first paragraph as failing to comply with the written description requirement. Specifically, the Examiner asserts that claim 1 recites the limitation "ceasing operation of the printing apparatus" and claim 9 recites "non-consumable memory" and these limitations are not supported by the specification. As stated above, claim 1 has been amended to properly fall within the scope of the specification. As additionally stated above, the subject limitation in claim 9 has been removed. As such, the rejections should be withdrawn.

Claim 1 is further rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Examiner asserts that the limitation "so that no other individual needs …" lacks antecedent basis and is unclear as to the identity of the first individual. Claim 1

has been amended to recite "so that the software upgrade for the printing apparatus does not need to be repeated." Accordingly, the rejection should be withdrawn.

V.   The Subject Claims Distinguish Patentably Over the References of Record

Claims 1-4, 7, and 9-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Richards et al. (U.S. 6,532,351) in view of Owen et al., (U.S. 2004/0080775) further in view of Hirst et al. (U.S. 5,930,553) further in view of Hara (U.S. 2004/004500). Applicants respectfully traverse the rejection.

Particularly, the references fail to teach or suggest a replaceable module for a printing apparatus including a microprocessor that performs instructions stored in an internal memory to compare currently installed software and current machine status with available software upgrades to determine if the software upgrade is appropriate. The Examiner asserts that Hirst teaches this feature; however, Applicant respectfully submits that the Examiner must have misinterpreted the teaching of Hirst. Hirst specifically teaches that a software upgrade is triggered at the time a consumable is replaced. Particularly, Hirst describes that the trigger may be activated by comparing a version number or manufacturing date for the new consumable with the previous version (See col. 3, lines 34-40), the use of a single shot fuse to detect a new toner cartridge after installation (See col. 4, lines 55-59), or extracting status of a consumable by a printer driver software and updating the consumable status and date information with every print job. Hirst fails to contemplate that an upgarde would be determined by a microprocessor following a set of stored instructions to compare currently installed <u>software and machine status with available software updates</u>.

The Examiner argues that Hirst teaches the claimed comparison because if a new consumable is identified based on comparison methods shown after installation and contains the desired code patch, then the necessary software patches are installed. However, such is not the case since the claim specifically recites that the microprocessor performs the stored instructions to compare the <u>actual software</u> currently installed and the <u>current machine status</u> with that of available software updates. Hirst is concerned only with the installation of a new consumable (See col. 3, lines 34-35), not the comparison of current to potential software. In Hirst, when a new consumable is installed, a software upgrade is automatically triggered. In the presently claimed invention, software upgrades only occur when the comparison between current and

potential software deems an upgrade appropriate.

Additionally, none of the cited references teach or suggest the claimed method of installing the software upgrade into the printing apparatus. The only teaching of installing a software upgrade in Hirst is shown in Figs. 5 and 6. In Fig. 5, once a new consumable is detected, the consumable memory is checked for updates to image forming device programming. If new updates are found, then the updates are downloaded from consumable memory and stored into appropriate non-volatile memory. There is no teaching or suggestion in Hirst of causing the printing apparatus to idle, updating the software, monitoring the progress of the upgrade, reporting any faults, contacting service personnel if upgrades are not successful, and returning the printing apparatus to normal operation when the upgrade is complete such that the upgrade does not need to be completed, as is presently claimed.

The Examiner cites Hara as teaching monitoring progress of the upgrade, reporting any faults, and contacting service personnel if the upgrades are not successfully completed. According to the Examiner, it would have been advantageous to modify the replacement module and system disclosed by Richards to include the techniques for operating printing consumables as taught by Owen and Hirst and software updating techniques as taught by Hara. The Examiner lists numerous advantages of the combination, and then states that it would have been obvious for one skilled in the art to combine the apparatus of Richards with those of Owen, Hirst, and Hara to reach the named advantages. However, Applicant submits that in all the listed advantages of the proposed combination, the Examiner has failed to provide any support that one skilled in the art, at the time of the invention, would have been motivated to make the proposed combination.

The Examiner remarks that a conclusion as to obviousness is in a sense necessarily a reconstruction based on hindsight reasoning. However, according to MPEP 706(j), "to support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." A list of various advantages of the proposed combination, without more, is a blatant example of an improper use of hindsight reasoning to create the presently claimed invention by piecemeal. As stated by the Federal Circuit, "it is impermissible to use the claimed invention as an instruction manual or

'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious. ... This court has previously stated that '[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780 (Fed. Cir. 1992).

Specifically, Hara is directed to software licensing management system and method intended to protect the licensees of software packages and prevent the use of illegally copied software. The system makes it possible to replace a terminal on which a software product is used within the scope of a current software license agreement while preventing illegal copying of the software. The Examiner fails to provide any reasoning as to why a person skilled in the art would look to the teachings of Hara when faced with the subject of the presently claimed invention, specifically creating a replaceable module for a printing apparatus with programmable software controls.

For at least the aforementioned reasons, Applicant submits that the subject claims distinguish patentably over the references of record. As such, Applicant respectfully requests that the rejections of claims 1-25 be withdrawn.

CONCLUSION

For the reasons detailed above, it is submitted all remaining claims (Claims 1-25) are now in condition for allowance. The foregoing comments do not require unnecessary additional search or examination.

Remaining Claims, as delineated below:

(1) FOR	(2) CLAIMS REMAINING AFTER AMENDMENT LESS HIGHEST NUMBER PREVIOUSLY PAID FOR		(3) NUMBER EXTRA
TOTAL CLAIMS	25	- 25 =	0
INDEPENDENT CLAIMS	3	- 3 =	0

This is an authorization under 37 CFR 1.136(a)(3) to treat any concurrent or future reply, requiring a petition for extension of time, as incorporating a petition for the appropriate extension of time.

The Commissioner is hereby authorized to charge any filing or prosecution fees which may be required, under 37 CFR 1.16, 1.17, and 1.21 (but not 1.18), or to credit any overpayment, to Deposit Account 24-0037.

In the event the Examiner considers personal contact advantageous to the disposition of this case, he/she is hereby authorized to call the undersigned, at Telephone Number (216) 363-9000.

Respectfully submitted,

FAY SHARPE LLP

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Date

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